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10/736,629	12/17/2003	Avery Fong	246161US2CONT	4751
22850 7590 01/08/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
TSUL, WILSON W				
ART UNIT		PAPER NUMBER		
2178				
NOTIFICATION DATE		DELIVERY MODE		
01/08/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/736,629

**Applicant(s)**

FONG ET AL.

**Examiner**

WILSON TSUI

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7,9-11,13-15,17-19,21,25-33 and 35 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1-3,5-7,9-11,13-15,17-19,21,25-33 and 35 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This non-final action is in response to the RCE filed on: 10/08/08.
2. Claims 1-3, 5-7, 9-11, 13-15, 17-19, 21-23, 25-27, 31-33, and 35 are amended. Claims 4, 8, 12, 16, 20, 24, and 34 are cancelled. Thus, claims 1-3, 5-7, 9-11, 13-15, 17-19, 21-13, 25-33, and 35 are pending. Claims 1, 9, and 17 are independent claims.
3. The previous rejections are withdrawn, in view of new grounds of rejections necessitated by applicant's amendments:
  - Claims 1-3, 5-7, 9-11, 13-15, 17-19, 21-23, and 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rada et al, in further view of Linden2.
  - Claims 4, 8, 12, 16, 20, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Rada et al, in view of Linden2; and further in view of Burnard.
4. The 35 USC 112 first rejection with regards to claim 34, is withdrawn, since claim 34 has been cancelled by the amendment.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 9, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regards to claim 1, the claim cites the limitation "without using an intermediate representation of the first document or database structure". However, the examiner respectfully points out that in Fig. 18A-2: a symbol table is used as an intermediate database-structure/document of the first document to aid in the transformation process. Additionally, the examiner directs attention to the applicant's specification that the symbol table is an intermediate format used to pass data to other modules in the system (page 23 of applicant's specification).

Thus, the claimed limitation in claim 1, appears to contradict, Fig 18A-2, since an intermediate database structure/document format (a symbol table) is used to perform the transformation; in view of the claim language citing "...without using an intermediate representation of the first document or database structure". The examiner respectfully asks where specifically in the specification is it enabled that an intermediate representation of the first document or database structure is not used, when as shown in Fig 18-2 (and explained in page 22 of applicant's specification), a Symbol table (a table having data structure) is used to perform a transformation.

With regards to claim 9, for citing the limitation "without using an intermediate representation of the first document or database structure", is rejected under similar rationale as the rejection for claim 1 above.

With regards to claim 17, for citing the limitation “without using an intermediate representation of the first document or database structure”, is rejected under similar rationale as the rejection for claim 1 above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 9, 17, and 29-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Linden et al ("Alchemist: A General Purpose Transformation Generator", published: June 1996, publisher: software-practice and Experience, pages: 653-675).

With regards to claim 1, Linden et al teaches:

*Inputting, into a map editor with a graphical user interface, a first structural description of a first native structured format (Figure 1, page 658: whereas the user inputs a first structural grammar of a first native structure format);*

*Inputting, into the map editor with the graphical user interface, a second structural description of a second native native structured format (Figure 1, page 658: whereas the user inputs a second structural grammar of a second native structure format);*

*Inputting, into the map editor by a user with the graphical user interface, preferences for transforming an element of the first structural description, in its native format, directly to at least one element of the second structural description in its native format (Figure 1, page 658, 659: whereas, the user inputs a mapping through production associations, such that one or more elements of a first structural description are transformed to at least one element of a second structural description.);*

*Storing translation information output from the map editor, the translation information comprising at least the preferences input by the user (Figure 1, pages 658 and 659: whereas code is compiled to produce translation information, based upon associations/preferences specified by the user);*

*and transforming a first document or database structure provided in the first native native native structured format directly into a second document or data structure in the second native native structured format based on the translation information, without using an intermediate representation of the first document or database structure (Figure 1, pages 658 and 659: whereas, compiled code is thus executed by the computer to*

transform a first document into a second document, without the user having to generate/produce an intermediate representation of the first document.).

With regards to claim 9, for a system performing a method similar to the method of claim 1, is rejected under the same rationale.

With regards to claim 17, for a computer program product performing a method similar to the method of claim 1, is rejected under the same rationale.

With regards to claim 28, which depends on claim 1, Linden et al teaches *generating transformation information based upon database design information* (page 659: specified through grammar), *document type* (page 665: whereas, based on the type of elements within the document, transformation information is further generated), and a *document* (page 663: whereas a source document is used to generate additional transformation data).

With regards to claim 29, which depends on claim 9, for a system performing a method similar to the method of claim 28, is rejected under similar rationale.

With regards to claim 30, which depends on claim 17, for a computer-readable medium encoded with instructions, which perform a method similar to the method of claim 28, is rejected under similar rationale.

With regards to claim 31, which depends on claim 1, Linden et al teaches *displaying the graphical user interface*, as similarly explained in the rejection for claim 1, and is rejected under similar rationale. Additionally, Linden et al further explains the graphical user interface *includes a first area that displays a list of tags of the first native native structured format* (page 656, figure 1: a first area is shown in the source grammar window), *a second area that displays a tag of the second native native structured format that a selected tag from the first area maps to* (page 656, figure 1: a second area is shown in the target grammar window); *and creating a mapping between the first native native structured format and the second native native structured format based on contents of the first and second areas* (page 656, figure 1: whereas the mapper tool (third area) is used to define a mapping, and the spell tool is used to compile/generate the mapping). The third area *that displays a list of legal tags which can follow a last tag in the second area* (page 661, and page 663: whereas, the third area (mapper tool) is used to define and display a list of legal tags by selecting productions and symbols to implement spells. The spells used to allow certain tags to follow a last tag based on order of structure data for output/transformation).

With regards to claim 32, which depends on claim 1, Linden et al teach *editing, with the graphical user interface, an existing map that transforms the first document or database structure provided in the first native native structured format into the second document or database structure in the second native native structured format*, as



similarly explained in the rejection for claim 31 (through the use of the mapper tool and spell tool), and is rejected under similar rationale.

With regards to claim 33, which depends on claim 1, Linden et al teach *creating, with the graphical user interface, a map that transforms the first document or database structure provided in the first native native structured format into the second document or database structure in the second native native structured format* (through the use of the mapper tool and spell tool), as similarly explained in the rejection for claim 31, and is rejected under similar rationale.

With regards to claim 35, which depends on claim 1, the Linden et al teaches *breaking down a structure of the first document or database structure into source components and structure based on the first native native structured format; Presenting the source components and structure to the user through the graphical user interface of the map editor; Interactively selecting, by the user through the graphical user interface, components of the first native native structured format with candidate target components of the second native native structured format; and interactively selecting, by the user through the graphical user interface, target components of the candidate target components for a mapping of the source components for creation of a rule for a transformation map* (page 656, 658, Figure 1: whereas, a structure is broken down and the source components of the first native native structured format are presented in the

mapper tool editor for selection by the user , desired candidate target components of a second native native structured format; such that a rule is created for a transformation.)

7. Claims 2, 3, 5-7, 10, 11, 13-15, 18, 19, 21-23, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden et al ("Alchemist: A General Purpose Transformation Generator", published: June 1996, publisher: software-practice and Experience, pages: 653-675), in further view of Rada et al ("Hypertext Interchange Using ICA", published: June 1995, pages 99-117).

With regards to claim 2, which depends on claim 1, Linden et al teaches *transforming the first structured document and first native native structured format*, as similarly explained in the rejection for claim 1, and is rejected under similar rationale. However, Linden et al does not expressly teach the first native native structured format *has a Document Type Definition (DTD) directed hierarchy*.

Yet, Rada et al teaches transforming *the first structured document, the first native native structured format has a Document Type Definition (DTD) directed hierarchy* (page 102: whereas, the first native structured format, can be SGML (which includes a DTD), such that the second format will be a structural format for a hypertext system). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Linden et al's transformation method, such that the first structured document has a native structured format having a DTD directed hierarchy, as

taught by Rada et al. The combination would have allowed Linden et al to have made it easier to generate translators between different markups (Rada et al, page 100).

With regards to claim 3, which depends on claim 1, the combination of Linden et al and Rada teaches wherein *the transforming includes transforming the document and said first native structured format is derived from Standard Generalized Markup Language (SGML)*, as similarly explained in the rejection for claim 2, and is rejected under the same rationale.

With regards to claim 5, which depends on claim 3, Linden et al teaches *transforming the second structured document and second native structured format*, as similarly explained in the rejection for claim 1, and is rejected under similar rationale. However, Linden et al does not expressly teach the second native structured format *has a Document Type Definition (DTD) directed hierarchy*.

Yet, Rada et al teaches transforming *wherein the second native structured format is a Document Type Definition (DTD) directed hierarchy* (page 102: whereas, the second native structured format, can be the open and interchange layer, and the first native structured format can be the text markup language, such that the second native structured format is SGML (which includes a DTD)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Linden et al's transformation method, such that the second structured document has a native structured format having a DTD directed hierarchy, as

taught by Rada et al. The combination would have allowed Linden et al to have The combination would have allowed Linden et al to have made it easier go generate translators between different markups (Rada et al, page 100).

With regards to claim 6, which depends on claim 3, Linden et al teaches further comprising: *outputting, from the editor to a graphical user interface, a representation of a translation between the first native native structured format and the second native native structured format* (Figure 1, page 658: whereas, the editor includes a spell tool to show and allow the user to view translation preferences, the translations used to implement associations between the first and second native structured format).

With regards to claim 7, which depends on claim 3, the combination of Linden et al and Rada teaches wherein *the second native structured format is derived from Standard Generalized Markup Language (SGML)*, as similarly explained in the rejection for claim 5, and is rejected under the same rationale.

With regards to claim 10, which depends on claim 9, for a system performing a method similar to the method of claim 2, is rejected under the same rationale.

With regards to claim 11, which depends on claim 9, for a system performing a method similar to the method of claim 3, is rejected under the same rationale.

With regards to claim 13, which depends on claim 11, for a system performing a method similar to the method of claim 5, is rejected under the same rationale.

With regards to claim 14, which depends on claim 11, for a system performing a method similar to the method of claim 6, is rejected under the same rationale.

With regards to claim 15, which depends on claim 11, for a system performing a method similar to the method of claim 7, is rejected under the same rationale.

With regards to claim 18, which depends on claim 17, for a computer program product performing a method similar to the method of claim 2, is rejected under the same rationale.

With regards to claim 19, which depends on claim 17, for a computer program product performing a method similar to the method of claim 3, is rejected under the same rationale.

With regards to claim 21, which depends on claim 19, for a computer program product performing a method similar to the method of claim 5, is rejected under the same rationale.

With regards to claim 22, which depends on claim 19, for a computer program product performing a method similar to the method of claim 6, is rejected under the same rationale.

With regards to claim 23, which depends on claim 19, for a computer program product performing a method similar to the method of claim 7, is rejected under the same rationale.

With regards to claim 25, which depends on claim 1, Linden et al teaches *wherein the preferences for transforming include a user selection of which elements of the first native structured format to map to the second native structured format* (Figure 1, page 666: whereas a list of spells can be selected as preferred transformation steps).

With regards to claim 26, which depends on claim 9, for a system performing a method similar to the method performed in claim 25, is rejected under similar rationale.

With regards to claim 27, which depends on claim 17, for a computer readable medium encoded with instructions which perform a method similar to the method performed in claim 25, is rejected under similar rationale.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-3, 5-7, 9-11, 13-15, 17-19, 21-23, 25-33, and 35 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CESAR B PAULA/  
Primary Examiner, Art Unit 2178

/Wilson Tsui/  
Patent Examiner

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January 04, 2009